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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,324	12/15/2004	Eric Deguyon Taylor	BA9308USPCT	6745
7590 David E Heiser E I du Pont de Nemours & Company Legal Patents Wilmington, DE 19898	03/12/2007		EXAMINER HABTE, KAHSAY	
			ART UNIT 1624	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE		
3 MONTHS	03/12/2007	PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/518,324	TAYLOR, ERIC DEGUYON	
	<b>Examiner</b>	<b>Art Unit</b>	
	Kahsay Habte	1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 06 February 2007.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-11 is/are pending in the application.
  - 4a) Of the above claim(s) 10 and 11 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-9 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 6/9/2005
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

1. Claims 1-11 are pending in this application.

### *Election/Restriction*

2. Applicant's election with traverse of Group I, Claims 1-9 filed 2/6/2007 is acknowledged. The traversal is on the ground(s) that "all of the claims of this application are linked by a single general inventive concept: the process sequence represented by (1), (2) and (3) in Claim 1 that can be used in connection with the preparation of fused oxazinones as recited in that claim.....Common structures involved in that sequence include a carboxylic acid, a sulfonyl chloride and a pyridine compound...Applicants submits that the process sequence is not restricted to particular J and K groups". The examiner disagrees with applicants. Unlike applicant's argument, the special technical feature of Groups I-II is different one from the other. The inventions listed as Groups I-II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the special technical feature of Group I is a benzo[1,3]oxazinone ring and is different from the special technical feature of Group II. The special technical feature of Group II is other fused oxazinones e.g. K = pyrido, pyrrole, etc. and is different from the special technical feature of Group I. Carboxylic acid and sulfonyl chloride is a reagent that is involved in the process, but they don't define the special technical feature of Groups I-II.

The special technical feature of Group I and Group III is different one from the other. The special technical feature of Group III involves ring-opening reaction of a benzo[1,3]oxazinone ring that is not present in Group I. Note that coexamination of each of the additional groups would require search of subclasses unnecessary for the examination of the elected claims. For example, the search for the invention of Group II would include search of various subclasses in class 544 and the search for the invention of Group III would include search of classes 546 and 548, subclass various. Therefore, coexamination of each of these additional inventions would require a serious additional burden of search.

The requirement is still deemed proper and is therefore made FINAL.

Claims 10-11 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention, the requirement having been traversed.

3. The claims are drawn to multiple inventions for reasons set forth in the restriction requirement. The claims are examined only to the extent that they read on the elected invention. Cancellation of the non-elected subject matter is recommended in response to this Office Action. It is required that applicants amend claim 1 by inserting the benzo[1,3]oxazinone moiety in place of "fused oxazinone". Applicants have also to limit the definition of J (see claim 8).

***Information Disclosure Statement***

4. Applicant's Information Disclosure Statement, filed on 06/9/2005 has been acknowledged. Please refer to Applicant's copies of the 1449 submitted herewith. Note that the document 10/518325 listed in the U.S. Patent Documents is not considered, because it is not a patent.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention:

a. In claim 1, the phrase "carboxylic acid" is indefinite. What is covered and what is not? Note that carboxylic acid is a functional group that is attached to J (J-COOH). Since applicants elected Group I, it is recommended that applicants limit the definition of J to pyrrole derivative.

b. Claim 2 and claims dependent thereon are rejected because the phrase "J is an optionally substituted carbon moiety" is indefinite. In the absence of the specific moieties intended to effectuate modification by the "substitution" or attachment to the

chemical core claimed, the term "substituted" renders the claims in which it appears indefinite in all occurrences wherein applicants fails to articulate by chemical name, structural formula or sufficiently distinct functional language, the particular moieties applicants regards as those which will facilitate substitution, requisite to identifying the composition of matter claimed. See above for suggestion to overcome this rejection.

c. Regarding claim 5 (page 71, lines 12 and 30), the phrase "including" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kahsay Habte whose telephone number is (571)-272-0667. The examiner can normally be reached on M-F (9.00- 5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kahsay Habte  
Primary Examiner  
Art Unit 1624

KH  
March 6, 2007